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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,262	03/21/2001	Charles Q. Meng	04676.105051 (ATH114US)	4560

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ATLANTA, GA 30303-1763

EXAMINER

LEWIS, PATRICK T

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 07/15/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/815,262

Applicant(s)

MENG ET AL.

Examiner

Patrick T. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23 and 28-35, drawn to a compound of formula (I), classified in class 536, subclass 1.1.
  - II. Claims 24-27, drawn to compound of formula (II), classified in class 585, subclass 24.
  - III. Claims 36-38, 40-42, 44-50, 52-54, 56-58, 64-66, and 68-70, drawn to a method for treating a disease or disorder mediated by VCAM-1 comprising administering an effect amount of compound of formula (I), classified in class 514, subclass 23.
  - IV. Claims 39, 43, 51, 55, 59, 6, and 71, drawn to a method for treating a disease or disorder mediated by VCAM-1 comprising administering an effect amount of compound of formula (II), classified in class 514, subclass 762.
  - V. Claims 60-62, drawn to a method for treating hypercholesterolemia or hyperlipidemia comprising administering an effect amount of compound of formula (I), classified in class 514, subclass 23.
  - VI. Claim 63, drawn to a method for treating hypercholesterolemia or hyperlipidemia comprising administering an effect amount of compound of formula (II), classified in class 514, subclass 762.

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2. Inventions (I and III) and (I and V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the methods of invention III or V may be practiced using compounds of invention II.

3. Inventions (I and II), (I and IV), and (I and VI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions I and II have different structural cores. A search for compounds of Group I will not necessitate a search for compounds for Group II, further, a reference rendering Group I obvious will not render Group II obvious. Applicant is not entitled to examination of multiple compounds. This indeed would place undue burden upon the examiner in charge of this application. Inventions (I and IV) and (I and VI) are unrelated because Inventions IV and VI use active agents different from Invention I.

4. Inventions (II and III) and (II and V) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions (II and III) and (II and V) are unrelated because Inventions III and V use active agents different from Invention I.

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5. Inventions (II and IV) and (II and VI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of inventions IV and VI may be practiced using compounds of invention I.

6. Inventions (III and IV), (III and V), and (III and VI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions IV and VI use different active agents from the active agents used to practice the method of Invention III. Inventions III and V differ because they are drawn to methods for treating different conditions.

7. Inventions (IV and V) and (IV and VI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions V and VI differ from Invention IV because Inventions V and VI are drawn to methods for treating different conditions.

8. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions employ different active agents.

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9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. It would indeed impose an undue burden upon the examiner in charge of this application if the instant restriction and species requirement were not advanced as set forth herein.

10. In the event applicant elects the invention of Group I, applicant is required to elect a species in accordance with the provisions set forth below:

Claim 1 generic to a plurality of disclosed patentably distinct species wherein **Z** is species **A** (substituted or unsubstituted carbohydrate) or species **B** (non-carbohydrate). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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### ***Contacts***

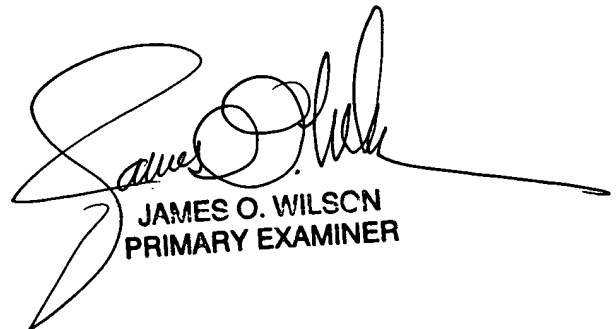
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis  
Examiner  
Art Unit 1623

ptl  
July 10, 2002



JAMES O. WILSCN  
PRIMARY EXAMINER